

REMARKS:

Claims 1-35 are currently pending in the application.

Claims 1, 4, 9, 11, 12, 15, 20, 22, 23, 26, 31, 33, and 33-35 stand rejected under 35 U.S.C. § 102(e) over U.S. Patent Publication No. 2003/0037063 to Schwartz ("*Schwartz*").

Claims 2, 13, and 24 stand rejected under 35 U.S.C. § 103(a) over *Schwartz* in view of U.S. Patent Publication No. 2003/0061246 to Bowman, *et al.* ("*Bowman*").

Claims 3, 5, 8, 10, 14, 16, 19, 21, 25, 27, 28, and 32 stand rejected under 35 U.S.C. § 103(a) over *Schwartz* in view of the Examiner's Official Notice.

Claims 6, 7, 17, 18, 28, and 29 stand objected to as being dependent upon a rejected base claim.

ALLOWABLE SUBJECT MATTER:

Claims 6, 7, 17, 18, 28, and 29 stand objected to as being dependent upon a rejected base claim.

Specifically, the Examiner states that "Claims 6, 7, 17, 18, 28, and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." (5 May 2006 Office Action, Page 14). The Applicants greatly appreciate the Examiner acknowledging that Claims 6, 7, 17, 18, 28, and 29 contain allowable subject matter.

REJECTION UNDER 35 U.S.C. § 102(e):

Claims 1, 4, 9, 11, 12, 15, 20, 22, 23, 26, 31, 33, and 33-35 stand rejected under 35 U.S.C. § 102(e) over *Schwartz*.

The Applicants respectfully submit that *Schwartz* fails to disclose each and every limitation recited by Claims 1, 4, 9, 11, 12, 15, 20, 22, 23, 26, 31, 33, and 33-35. The Applicants further submit that Claims 1, 4, 9, 11, 12, 15, 20, 22, 23, 26, 31, 33, and 33-35 patentably distinguish over *Schwartz*. Thus, the Applicants respectfully traverse the Examiners rejection of Claims 1, 4, 9, 11, 12, 15, 20, 22, 23, 26, 31, 33, and 33-35 under 35 U.S.C. § 102(e) over *Schwartz*.

***Schwartz* Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Claims**

For example, with respect to independent Claim 1, this claim recites:

A system for generating a risk assessment regarding a software implementation project, the system comprising one or more software components collectively operable to:

access a previously specified importance value and maximum score for each of a plurality of risk factors, the importance value for each risk factor reflecting experience of an implementing entity regarding the ***extent to which the risk factor may negatively impact a software implementation project if the risk factor is not adequately addressed***, the importance value and maximum score for each risk factor being multiplied to define a potential weighted score for the risk factor;

receive an actual score for a particular software implementation project for each risk factor based on an analysis by the implementing entity specific to the particular software implementation project;

generate an actual weighted score for the particular software implementation project for each risk factor by multiplying the importance value and actual score for the risk factor;

determine a relationship between the potential weighted score and the actual weighted score for each risk factor;

assign a risk level for the particular software implementation project to each risk factor according to the relationship between the potential weighted score and the actual weighted score for the risk factor, the risk level for each risk factor representing an assessment by the implementing entity regarding the extent to which the risk factor may negatively impact the particular software implementation project if the risk factor is not adequately addressed; and

generate a risk assessment for the particular software implementation project comprising one or more of the assigned risk levels for the particular software implementation project for one or more corresponding risk factors. (Emphasis Added).

Independent Claims 12, 23, 34, and 35 recite similar limitations. *Schwartz* fails to disclose each and every limitation of independent Claims 1, 12, 23, 34, and 35.

The Applicants respectfully submit that *Schwartz* has nothing to do with independent Claim 1 limitations regarding a ***“system for generating a risk assessment regarding a software implementation project”*** and in particular *Schwartz* has nothing to do with independent Claim 1 limitations regarding ***“access[ing] a previously specified importance value and maximum score for each of a plurality of risk factors, the importance value for each risk factor reflecting experience of an implementing entity regarding the extent to which the risk factor may negatively impact a software implementation project if the risk factor is not adequately addressed, the importance value and maximum score for each risk factor being multiplied to define a potential weighted score for the risk factor”***. In particular, the Examiner equates the ***“software implementation project”*** recited in independent Claim 1 with the “network based method and system for risk assessment, risk monitoring and caseload management” disclosed in *Schwartz*. (5 May 2006 Office Action, Page 5). However, ***the network based network and system for risk assessment, risk monitoring and caseload management disclosed in Schwartz*** is merely directed towards risk assessment of people who are under supervision because they may be subject to some form of risk, such as mental health patients or parolees, and ***does not include, involve, or even relate to a software implementation project***. (Abstract and Paragraph 0047). In contrast, the ***“software implementation project”*** recited in independent Claim 1 ***provides for risk assessment process that facilitates consistent comparison of one software implementation project to other software implementation projects and provides a mechanism for measuring improvement across software implementation projects***. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner’s comparison between *Schwartz* and independent Claim 1 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Schwartz*.

The Applicants further respectfully submit that *Schwartz* has nothing to do with independent Claim 1 limitations regarding ***“receive[ing] an actual score for a***

particular software implementation project for each risk factor based on an analysis by the implementing entity specific to the particular software implementation project". In particular, the Examiner equates "*receive[ing] an actual score for a particular software implementation project*" recited in independent Claim 1 with the "logs" disclosed in *Schwartz*. (5 May 2006 Office Action, Page 6). However, *the logs disclosed in Schwartz* are merely client logs that may include information about the primary client and associated secondary clients and *have nothing to do with receive[ing] an actual score for a particular software implementation project or is not even related to an implementing entity specific to the particular software implementation project*. (Paragraph 0097). In contrast, "*receive[ing] an actual score for a particular software implementation project*" recited in independent Claim 1 provides for receiving an actual score for a *particular software implementation project* for each risk factor and is based on an analysis by the *implementing entity* which is specific to the particular *software implementation project*. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner's comparison between *Schwartz* and independent Claim 1 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Schwartz*.

The Applicants still further respectfully submit that *Schwartz* has nothing to do with independent Claim 1 limitations regarding "*generat[ing] a risk assessment for the particular software implementation project comprising one or more of the assigned risk levels for the particular software implementation project for one or more corresponding risk factors*". In particular, the Examiner equates "*generat[ing] a risk assessment for the particular software implementation project*" recited in independent Claim 1 with the "high-risk assessment" disclosed in *Schwartz*. (5 May 2006 Office Action, Pages 7-8). However, *the high-risk assessment disclosed in Schwartz* is merely provided to notify a worker that follow-up communication to the client is necessary and *has nothing to do with generat[ing] a risk assessment for the particular software implementation project*. (Paragraph 0101). In contrast, "*generat[ing] a risk assessment for the particular software implementation project*" recited in independent Claim 1 comprises one or more of the assigned risk levels for the

particular **software implementation project** for one or more corresponding risk factors. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner's comparison between *Schwartz* and independent Claim 1 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Schwartz*.

The Office Action has Failed to Properly Establish a *Prima Facie* case of Anticipation over *Schwartz*

The Applicants respectfully submit that the allegation in the present Office Action that *Schwartz* discloses all of the claimed features is respectfully traversed. Further, it is noted that the Office Action provides no concise explanation as to how *Schwartz* is considered to anticipate all of the limitations in Claims 1, 4, 9, 11, 12, 15, 20, 22, 23, 26, 31, 33, and 33-35. ***A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if each and every element of a claimed invention is identically shown in that single reference.*** MPEP § 2131. (Emphasis Added). With respect to the subject application, the Examiner has not adequately supported the rejection under 35 U.S.C. § 102, because the Examiner has not shown how each and every element of the Applicants claimed invention is identically shown in *Schwartz*. For example, the Examiner asserts that the “**software implementation project**”, in independent Claim 1 is somehow equivalent to the network based method and system for risk assessment, risk monitoring and caseload management. (5 May 2006 Office Action, Page 5). The Applicants respectfully disagree and further respectfully request clarification as to how the Examiner arrives at this conclusion. In another example, the Examiner asserts that “**receive[ing] an actual score for a particular software implementation project**”, in independent Claim 1 is somehow equivalent to logs. (5 May 2006 Office Action, Page 6). The Applicants respectfully disagree and further respectfully request clarification as to how the Examiner arrives at this conclusion. In still another example, the Examiner asserts that “**generat[ing] a risk assessment for the particular software implementation project**”, in independent Claim 1 is somehow equivalent to high-risk assessment. (5 May 2006 Office Action, Pages 7-8). The Applicants respectfully disagree and further respectfully request clarification as to how the Examiner arrives at this conclusion. The Applicants

respectfully point out that "it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." Ex parte Levy, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). The Applicants respectfully submit that ***the Office Action has failed to establish a prima facie case of anticipation in Claims 1, 4, 9, 11, 12, 15, 20, 22, 23, 26, 31, 33, and 33-35 under 35 U.S.C. § 102 with respect to Schwartz because Schwartz fails to identically disclose each and every element of the Applicants claimed invention, arranged as they are in Applicants claims.***

The Applicants Claims are Patentable over Schwartz

With respect to independent Claims 12, 23, 34, and 35 these claims include limitations similar to those discussed above in connection with independent claim 1. Thus, independent Claim 12, 23, 34, and 35 are considered patentably distinguishable over *Schwartz* for at least the reasons discussed above in connection with independent claim 1.

Furthermore, with respect to dependent Claims 4, 9, 11, 15, 20, 22, 26, 31, and 33: Claims 4, 9, and 11 depend from independent claim 1; Claims 15, 20, and 22 depend from independent claim 12; and Claims 26, 31, and 33 depend from independent claim 23 are also considered patentably distinguishable over *Schwartz*. Thus, dependent Claims 4, 9, 11, 15, 20, 22, 26, 31, and 33 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, for at least the reasons set forth herein, the Applicants respectfully submit that independent Claims 1, 12, 23, 34, and 35 and dependent Claims 4, 9, 11, 15, 20, 22, 26, 31, and 33 are not anticipated by *Schwartz*. The Applicants further respectfully submit that independent Claims 1, 12, 23, 34, and 35 and dependent Claims 4, 9, 11, 15, 20, 22, 26, 31, and 33 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of Claims 1, 4, 9, 11, 12, 15, 20, 22, 23, 26, 31, 33, and 33-35 under 35 U.S.C. § 102(e) be reconsidered and that Claims 1, 4, 9, 11, 12, 15, 20, 22, 23, 26, 31, 33, and 33-35 be allowed.

THE LEGAL STANDARD FOR ANTICIPATION REJECTIONS UNDER 35 U.S.C. § 102:

The following sets forth the legal standards for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. Prior Knowledge: The invention was publicly known in the United States before the patentee invented it.
2. Prior Use: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.
3. Prior Publication: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.
4. Prior Patent: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.
5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.
6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.
7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.
2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.
3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.
4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.
2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The

effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimentation rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 2, 13, and 24 stand rejected under 35 U.S.C. § 103(a) over *Schwartz* in view of *Bowman*. Claims 3, 5, 8, 10, 14, 16, 19, 21, 25, 27, 20, and 32 stand rejected under 35 U.S.C. § 103(a) over *Schwartz* in view of the Examiner's Official Notice.

The Applicants respectfully submit that *Schwartz* or *Bowman*, either individually or in combination, fails to disclose, teach, or suggest each and every element of Claims 2, 13, and 24. The Applicants further respectfully submit that *Schwartz* or the Examiner's Official Notice, either individually or in combination, fails to disclose, teach, or suggest each and every element of Claims 3, 5, 8, 10, 14, 16, 19, 21, 25, 27, 20, and 32. Thus, the Applicants respectfully traverse the Examiner's obvious rejection of Claims 2, 3, 5, 8, 10, 13, 14, 16, 19, 21, 24, 25, 27, 20, and 32 under 35 U.S.C. § 103(a) over the proposed combination of *Schwartz*, *Bowman*, and the Examiner's Official Notice, either individually or in combination.

The Proposed *Schwartz-Bowman* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Dependent Claims 2, 13, and 24

For example, with respect to dependent claim 2, this claim recites:

The system of Claim 1, wherein the software components are further operable to ***generate a risk assessment scorecard for display***, the risk assessment scorecard providing the risk factors and the importance value, maximum score, potential weighted score, actual score, actual weighted score, and risk level for each risk factor in a spreadsheet format. (Emphasis Added).

Dependent claims 13 and 24 recite similar limitations. *Schwartz* and *Bowman*, either individually or in combination, fail to disclose each and every limitation of dependent claims 2, 13, and 24.

The Applicants respectfully submit that the Office Action acknowledges, and the Applicants agree, that *Schwartz* fails to disclose the emphasized limitations noted above in independent claim 1. Specifically the Examiner acknowledges that *Schwartz* fails to teach ***a system for generating a risk assessment regarding a software implementation project*** comprising one or more software components collectively operable to ***generate a risk assessment scorecard for display***. (5 May 2006 Office Action, Page 9). However, the Examiner asserts that the cited portions of *Bowman* disclose the

acknowledged shortcomings in *Schwartz*. The Applicants respectfully traverse the Examiner's assertions regarding the subject matter disclosed in *Bowman*.

The Applicants respectfully submit that *Bowman* has nothing to do with dependent claim 2 limitations regarding a **"system for generating a risk assessment regarding a software implementation project"** and in particular *Bowman* has nothing to do with dependent claim 2 limitations regarding **"generat[ing] a risk assessment scorecard for display"**, the risk assessment scorecard providing the risk factors and the importance value, maximum score, potential weighted score, actual score, actual weighted score, and risk level for each risk factor in a spreadsheet format". In particular, it appears that the Examiner is equating the **"risk assessment scorecard"** recited in dependent claim 2 with the "scorecard" disclosed in *Bowman*. (5 May 2006 Office Action, Pages 9-10). However, the "scorecard" disclosed in *Bowman*, merely provides a Project Assessment Form (PAF) scorecard tab associated with the project/initiative and **does not include or is not even related to generat[ing] a risk assessment scorecard for display**, as recited in independent claim 1. (Paragraph 401). In contrast, the limitations recited in dependent claim 2 provide for **"generat[ing] a risk assessment scorecard for display"**, the risk assessment scorecard providing the risk factors and the importance value, maximum score, potential weighted score, actual score, actual weighted score, and risk level for each risk factor in a spreadsheet format". Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner's comparison between *Bowman* and dependent claim 2 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish dependent claim 2 from *Bowman*.

The Office Action has Failed to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Schwartz-Bowman* Combination

The Applicants respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Schwartz* or *Bowman*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the

invention to combine these references as proposed. The Office Action merely states that “it would have been obvious to one of ordinary skill in the art at the time of the invention **to modify the risk assessment system of Schwartz with the scorecard feature of Bowman**”. (5 May 2006 Office Action, Page 10). (Emphasis Added). The Applicants respectfully disagree.

The Applicants further respectfully submit that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Schwartz* or *Bowman*, either individually or in combination. The Examiner asserts that the motivation to combine the references as proposed would be “**to provide a more user-friendly means of displaying the data**.” (5 May 2006 Office Action, Page 10). (Emphasis Added). The Applicants respectfully disagree and further respectfully request clarification as to how the Examiner arrives at this conclusion. For example, how does “**provid[ing] a more user-friendly means of displaying the data**” directly relate to “**modif[ing] the risk assessment system of Schwartz with the scorecard feature of Bowman**” and to what extent does the Examiner purport that “**provid[ing] a more user-friendly means of displaying the data**” even applies to the subject Application. **The Applicants respectfully request the Examiner to point to the portions of Schwartz or Bowman which contain the teaching, suggestion, or motivation to combine these references for the for the Examiner’s stated purported advantage.** In particular, the Applicants respectfully request the Examiner to point to the portions of *Schwartz* or *Bowman* which expressly state that “**provid[ing] a more user-friendly means of displaying the data**” relates to **modif[ing] the risk assessment system of Schwartz with the scorecard feature of Bowman**. The Applicants further respectfully submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the **prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common

sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the ***Examiner has not adequately supported the selection and combination of Schwartz or Bowman to render obvious the Applicants claimed invention.*** The Examiner's conclusory statements that "it would have been obvious to one of ordinary skill in the art at the time of the invention ***to modify the risk assessment system of Schwartz with the scorecard feature of Bowman***" and "***to provide a more user-friendly means of displaying the data***", ***does not adequately address the issue of motivation to combine.*** (5 May 2006 Office Action, Page 10). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, ***the Office Action fails to provide proper motivation for combining the teachings of Schwartz or Bowman***, either individually or in combination.

The Proposed Schwartz-Official-Notice Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Dependent Claims 3, 5, 8, 10, 14, 16, 19, 21, 25, 27, 20, and 32

The Applicants respectfully submit that the Office Action acknowledges, and the Applicants agree, that *Schwartz* fails to disclose the limitations in dependent Claims 3, 5, 8, 10, 14, 16, 19, 21, 25, 27, 20, and 32. (5 May 2006 Office Action, Pages 10-13). However, the Examiner asserts that the Examiner's Official Notice discloses the acknowledged shortcomings in *Schwartz*. The Applicants respectfully traverse the Examiner's assertions regarding the Examiner's Official Notice.

The Examiner's Official Notice is improper under MPEP § 2144.03

The Applicants respectfully submit that the Applicants are confused as to what the Examiner purports to teach by the Official Notice or even the extent in which the Examiner is taking Official Notice. The Applicants respectfully request clarification as to the subject matter for which the Examiner is taking Official Notice. ***The Applicants respectfully***

traverse the Official Notice because the asserted facts, as best understood by the Applicants, are not supported by substantial documentary evidence or any type of documentary evidence and appear to be the Examiner's opinions formulated using the subject Application as a template, which constitutes impermissible use of hindsight. Furthermore, under these circumstances, it is inappropriate for the Examiner to take Official Notice without documentary evidence to support the Examiner's conclusion. (See MPEP § 2144.03). **The Applicants respectfully request the Examiner to produce authority for the Examiner's Official Notice.**

Only "in limited circumstances," is it "appropriate for an examiner to take official notice of facts not in the record or to rely on common knowledge in making a rejection". (MPEP § 2144.03). "Official notice unsupported by documentary evidence **should only be taken by the examiner** where the facts asserted to be well-known, or to be common knowledge in the art are **capable of instant and unquestionable demonstration as being well-known**. With respect to the subject Application, **the Examiner's statement** that "**Official Notice is taken that it is old and well known in the arts to have a range of values for rating risk factors**", "that both the concept and advantage of **mathematical manipulation** are well known and expected in the art", "that both the concept and advantage of having **the seller install the software** is well known and expected in the art", **and** "that both the concept and advantage of **calculating a risk factor utilizing the formula mentioned** is well known and expected in the art", **is not capable of instant and unquestionable demonstration as being well-known**" (5 May 2006 Office Action, Pages 10-13). (Emphasis Added). As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be '**capable of such instant and unquestionable demonstration as to defy the dispute**' (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961))." (MPEP § 2144.03(A)). (Emphasis Added).

"It is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. (Emphasis Added). As the court held in *Zurko*, an assessment of basic knowledge and common sense that is

not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002).” (MPEP § 2144.03(A)). “Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that ***general conclusions concerning what is “basic knowledge” or “common sense” to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection***). The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.” (MPEP § 2144.03(B)). (Emphasis Added).

With respect to the subject Application, ***the Examiner has not properly Officially Noticed or not properly based the Official Notice on common knowledge***. The Examiner's conclusory statement:

Official Notice is taken that it is old and well known in the arts to have a range of values for rating risk factors, that both the concept and advantage of ***mathematical manipulation*** are well known and expected in the art, that both the concept and advantage of having ***the seller install the software*** is well known and expected in the art, ***and*** that both the concept and advantage of ***calculating a risk factor utilizing the formula mentioned*** is well known and expected in the art. (5 May 2006 Office Action, Pages 10-13). (Emphasis Added)

The above noticed Examiner's conclusory statement ***does not adequately address the issue that this statement is considered to be common knowledge or well-known in the art***. The Applicants respectfully submit the following statement, to further explain why the Examiner's above noticed statement is not considered to be common knowledge or well-known in the art.

First, it is not clear what the Examiner means by “*it is old and well known* in the arts *to have a range of values for rating risk factors*” (i.e. what “*range*” is the Examiner referring to and to what extent does the Examiner purport these “*range of values*” applies to the subject Application). In fact, the limitations recited in dependent Claim 3 are directed to a “*system for generating a risk assessment regarding a software implementation project*” and in particular to a “*risk factor remain constant across multiple software implementation projects*”. It is not clear how the Examiner’s purported Official Notice relates to the “*system for generating a risk assessment*” or even how it relates to the “*software implementation project*”.

Second, it is not clear what the Examiner means by “both the concept and advantage of *mathematical manipulation* are well known and expected in the art” (i.e. what “*mathematical manipulation*” is the Examiner referring to and how is it “*well known and expected in the art*”). In fact, the limitations recited in dependent Claim 5 are directed to a “*system for generating a risk assessment regarding a software implementation project*” and in particular to “generat[ing] a risk assessment for each risk factor category according to a category percentage risk for each risk factor category”. It is simply not clear what the Examiner means by “*mathematical manipulation[s]* are well known and expected in the art” or even how the Examiner’s conclusory statement relates to the subject Application. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner’s comparison between the Examiner’s purported Official Notice and amended independent Claim 1 cannot be made.

Third, it is not clear what the Examiner means by “both the concept and advantage of having *the seller install the software* is well known and expected in the art” (i.e. what *installation of the software* is the Examiner referring to and how is this “*well known and expected in the art*”). In fact, the limitations recited in dependent Claim 8 are directed to a “*system for generating a risk assessment regarding a software implementation project*” and in particular wherein “the *implementing entity is a seller* of software to be *implemented in the particular software implementation project at one or more sites of a client*”. It is simply not clear what the Examiner means by “having *the seller install the software*” or even how the Examiner’s conclusory statement relates to the subject

Application. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner's comparison between the Examiner's purported Official Notice and amended independent Claim 1 cannot be made.

Fourth, it is not clear what the Examiner means by "both the concept and advantage of *calculating a risk factor utilizing the formula mentioned* is well known and expected in the art" (i.e. what *formula* is the Examiner referring to and how is "*calculating a risk factor*" "*well known and expected in the art*"). In fact, the limitations recited in dependent Claim 10 are directed to a "*system for generating a risk assessment regarding a software implementation project*" and in particular wherein "the *relationship between the potential weighted score and the actual weighted score for each risk factor*, determining assignment of the risk level for the risk factor, *is a percentage based on one minus the quotient of the actual weighted score and the potential weighted score for each risk factor*". It is simply not clear what the Examiner means by "*calculating a risk factor utilizing the formula*" or even how the Examiner's conclusory statement relates to the subject Application. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner's comparison between the Examiner's purported Official Notice and amended independent Claim 1 cannot be made.

Finally, as explained above, the Examiner's statement that "**Official Notice is taken that it is old and well known in the arts to have a range of values for rating risk factors**", "that both the concept and advantage of *mathematical manipulation* are well known and expected in the art", "that both the concept and advantage of having *the seller install the software* is well known and expected in the art", **and** "that both the concept and advantage of *calculating a risk factor utilizing the formula mentioned* is well known and expected in the art" is not considered to be common knowledge or well-known in the art. The Applicants respectfully submit that there is simply no disclosure, teaching, or suggestion in *Schwartz* or the Examiner's Official Notice to the contrary.

The Applicants respectfully submit that the Office Action provides no documentary evidence to support the Official Notice taken by the Examiner, yet the asserted facts are

not capable of “instant and unquestionable” demonstration as being well-known. ***The Applicants respectfully request the Examiner to produce authority for the Examiner’s statement.***

The Applicants further respectfully submit that ***the Applicants have adequately traversed the Examiner’s assertion of Official Notice*** and direct the Examiner’s attention to the pertinent text of the MPEP, which states:

If applicant adequately traverses the examiner’s assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). (MPEP § 2144.03(C)).

Thus, if the Examiner continues to maintain the rejection of Claims 3, 5, 8, 10, 14, 16, 19, 21, 25, 27, 20, and 32 based on the Official Notice, ***the Applicants respectfully request that the Examiner provide documentary evidence as necessitated by MPEP § 2144.03(C)***. Furthermore, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, ***the Applicants further request that the Examiner provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding as further necessitated by MPEP § 2144.03(C)***.

The Office Action has Failed to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Schwartz-Official-Notice* Combination

The Applicants respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Schwartz* or the Examiner’s Official Notice, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the

time of the invention to combine these references as proposed. The Office Action merely states that “it would have been obvious to one of ordinary skill in the art at the time of the invention to manipulate the data by adding, dividing and multiplying combinations of data to facilitate the analysis of the information”, “to have used the seller to install the software to provide a more efficient means for initial set up of the system”, and “to calculate a risk factor this way to provide a means for weighting the risk and thus providing a more accurate score.” (5 May 2006 Office Action, Page 10-13). The Applicants respectfully disagree.

The Applicants further respectfully submit that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Schwartz* or the Examiner’s Official Notice, either individually or in combination. In addition, ***the Examiner is silent on the motivation to combine the references as proposed.*** The Applicants respectfully request clarification as to how the Examiner arrives at any motivation to combine the references as proposed. In particular, ***the Applicants respectfully request the Examiner to point to the portions of Schwartz or the Examiner’s Official Notice which contain the teaching, suggestion, or motivation to combine these references for the Examiner’s stated purported advantage.*** The Applicants respectfully submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.*** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the ***Examiner has not adequately supported the selection and combination of Schwartz or the Examiner’s Official Notice to render obvious the Applicants claimed invention.*** The Examiner’s conclusory statements that “it would have been obvious to one of ordinary” and that “it would have been obvious to one of ordinary skill in the art at the time of the invention to manipulate the data by adding,

dividing and multiplying combinations of data to facilitate the analysis of the information”, “to have used the seller to install the software to provide a more efficient means for initial set up of the system”, and “to calculate a risk factor this way to provide a means for weighting the risk and thus providing a more accurate score”, **does not adequately address the issue of motivation to combine.** (5 May 2006 Office Action, Page 10-13). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to “[use] that which the inventor taught against its teacher.” *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, **the Office Action fails to provide proper motivation for combining the teachings of Schwartz or the Examiner’s Official Notice**, either individually or in combination.

The Applicants Claims are Patentable over the Proposed Schwartz-Bowman-Official-Notice Combination

The Applicants respectfully submit that independent Claim 1 is considered patentably distinguishable over the proposed combination of *Schwartz, Bowman*, and the Examiner’s Official Notice. This being the case, independent Claims 12, 23, 34, and 35 are also considered patentably distinguishable over the proposed combination of *Schwartz, Bowman*, and the Examiner’s Official Notice.

With respect to dependent Claims 2, 3, 5, 8, 10, 13, 14, 16, 19, 21, 24, 25, 27, 20, and 32: Claims 2, 3, 5, 8, and 10 depend from independent Claim 1; Claims 13, 14, 16, 19, and 21 depend from independent Claim 12; and Claims 24, 25, 27, 20, and 32 depend from independent Claim 23. As mentioned above, each of independent Claims 1, 12, 23, 34, and 35 are considered patentably distinguishable over *Schwartz, Bowman*, and the Examiner’s Official Notice. Thus, dependent Claims 2, 3, 5, 8, 10, 13, 14, 16, 19, 21, 24, 25, 27, 20, and 32 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicants respectfully submit that Claims 2, 3, 5, 8, 10, 13, 14, 16, 19, 21, 24, 25, 27, 20, and 32 are not rendered obvious

by the proposed combination of *Schwartz, Bowman*, and the Examiner's Official Notice. The Applicants further respectfully submit that Claims 2, 3, 5, 8, 10, 13, 14, 16, 19, 21, 24, 25, 27, 20, and 32 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of Claims 2, 3, 5, 8, 10, 13, 14, 16, 19, 21, 24, 25, 27, 20, and 32 under 35 U.S.C. § 103(a) be reconsidered and that Claims 2, 3, 5, 8, 10, 13, 14, 16, 19, 21, 24, 25, 27, 20, and 32 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.*** Second, there must be a reasonable expectation of success. Finally, ***the prior art reference*** (or references when combined) ***must teach or suggest all the claim limitations.*** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, ***and not based on applicant's disclosure.*** *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, ***there must be something in the prior art as a whole to suggest the desirability,*** and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have

suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:


In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although the Applicants believe no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

8/1/06
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